

REMARKS

The Restriction dated December 20, 2006 (hereafter “Restriction”) requires an election for examination between two sets of claims. The first set of claims is designated as claims 1-4, 14-20, 22-28, and 30-37 (hereafter “first claim set”), and the second set of claims is designated as claims 6-10, 12, 13, 21, and 29 (hereafter “second claim set”).

Applicants respectfully traverse this restriction for at least the reasons set forth below.

First, the restriction has not been timely filed. 37 CFR 1.142(a) entitled “Requirement for Restriction” states that “Such requirement [a restriction] will normally be made before any action on the merits; however, it may be made at any time before final action.”

Two final office actions have been issued in the present application. The first one was issued on July 16, 2004 and the second one was issued on July 28, 2005. Accordingly, because this application has been finally rejected, a restriction of the claims is improper at this time under 37 CFR 1.142(a).

Second, the restriction of the claims is traversed because the Restriction mischaracterizes the second claim set. Section one of the Restriction characterizes the first claim set as:

drawn to accessing a memory array wherein first and second addresses are decoded and a row address decoder is responsive to less significant bits of the first and second addresses and a column address decoder is responsive to more significant bits of the first and second addresses.

The second claim set is characterized as:

drawn to accessing a memory array wherein each storage element corresponds to a memory address.

Applicants respectively submit that the description of the second claim set misrepresents the relationship between the claims of the first claim set and the second claim set in that claim 6 (the only independent claim of the second claim set) sets forth a column decoder “operable responsive to at least one of the more significant bits” of an address and a row decoder “operable responsive to at least one of the less significant bits” of an address.

Third, Section 2 of the Restriction is incorrect in its reasoning for stating that the groups of claims are distinct. For example, Section 2 states that “subcombination II has separate utility

such as use with only a single address representing the storage elements, whereas the operation of subcombination I is limited to plural addresses.”

Applicants respectfully submit that this statement is incorrect. For example, claim 6 (of the second claim set) recites an array of storage elements where *each* of the storage elements corresponds to a numeric address. Consequently, with claim 6, a single address does not “represent” the storage elements. Accordingly, the characterization of the second claim set as set forth in Section 2 of the Restriction is incorrect.

Fourth, the restriction of the claims is not proper because the Restriction did not establish that there would be a serious burden on the Examiner if a restriction is not required. Section 3 of the Restriction states that “there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search.”

Applicants respectfully submit that the Restriction has not established that the two sets of claims would require a different field of search, especially since both Section 1 and Section 2 of the Restriction are incorrect in their characterization of the second claim set.

Furthermore, the long prosecution history of this application would demonstrate that it would not be a serious burden for an Examiner to search together the prior art for the claims of both the first claim set and the second claim set.

For example, there have been FOUR non final office actions and TWO final office issued before this restriction. Assuming that there was a search performed before each non final office action (at least four different searches), it was not considered burdensome in those at least four searches to search together for prior art for both claim sets.

After four non final office actions, two final office actions, two advisory actions, and two appeal briefs, Applicants do not see why it is now necessary that the claims be restricted into two groups when at least four searches have been previously done on all the claims together.

Furthermore, Applicants note that in the last Office Action dated June 28, 2006, all rejected claims were not only rejected under the same references (e.g. Okuno and AAPA in one rejection) but that the rejection of the rejected independent claims 1, 6, 14, 16, 22, and 25 were described as being taught by the prior art in the same way. See for example, page 3 and page 7 of the last Office Action where it states “With respect to independent claims 1, 6, 14, 16, 22, and 25, **using claim 1 as representative...**” In other words, the last office action in its rejections of the independent claims essentially stated that claim 1 (of the first claim set) was representative of

claim 6 (of the second claim set). If it is a serious burden on an Examiner to search for prior art for independent claim 6 (of the second claim set) during a search for prior art for the other independent claims 1, 14, 16, 22, or 25 (of the first claim set), why would the last Office Action state that claim 1 was representative of claim 6 in rejecting the claims over the cited art?

Because there have been at least four searches of all claims in this application, and because previous office actions have grouped the two claim sets together in the rejection of those claims, Applicants respectfully submit that it would not be a serious burden on an Examiner to search together, **for at least the fifth time**, the art on the claims of claim set 1 and claim set 2.

Applicants provisionally elect, the first set of claims, claims 1-4, 14-20, 22-28, and 30-37 for examination.

Applicants believe the application is in condition for allowance which action is respectfully solicited. Please contact the below-signed if there are any issues regarding this communication or otherwise concerning the current application.

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